

REMARKS

In response to the Non-Final Office Action issued March 30, 2011, reconsideration of the application in light of the amendments and the following remarks is respectfully requested.

Substance of Interview

This is a statement of the substance of a telephonic interview conducted on July 25, 2011 between Melvin C. Garner (the undersigned), Mitsu Haraguchi, and Examiner Robert Mosser. The undersigned and Mitsu Haraguchi contacted the Examiner to discuss a proposed amendment that had been provided prior to the interview. The undersigned began with a discussion of rejections made under 35 USC 112, first paragraph. The undersigned stated that previously amended term, "uniquely visually differentiating" is being replaced with other language that is closer to the original term used in the priority document. The Examiner stated that rule 37 CFR 1.57 allows for incorporating the content of the priority document by reference without a specific statement, but it only applies to applications filed on or after September 21, 2004. The instant application was filed on September 22, 2003. The undersigned thanks the Examiner for this notification, and as a result has revised the proposed amendment so that it conforms to the specification.

As for rejections under 35 USC 103(a), the undersigned noted that the combination of Bennett with other prior art references does not disclose the features of the present invention. The undersigned stated that the prior art to Cannon teaches away from a combination with Inoue. However, the Examiner suggested that the argument distinguishing over Bennett would be more effective in overcoming the rejections, since Bennett is the primary reference. The undersigned also discussed amendments made to overcome a rejection against claim 7. The undersigned thanks the Examiner for his time and consideration during the interview.

Status of the Claims

Claims 1-4, 6-11, 14-16, 18-20, and 22-29 are currently pending, with claims 5, 12, 13, 17 and 21 having previously been canceled without prejudice or disclaimer of the subject matter therein. In this response, claims 1, 4, 7, 8, 18 and 24 have been amended. Claims 30-37 have been added. No new matter is introduced.

Rejections Under 35 U.S.C. §112

Claims 1-4, 6-11, 14-16, 18-20, and 22-29 were rejected under the first paragraph of 35 U.S.C. § 112, because the Examiner takes the position that the specification does not reasonably provide enablement for “uniquely visually differentiates” wins including a wild symbol from other wins. The Examiner particularly states that “[t]here is no language present in the specification as originally presented that would otherwise indicate that the applicant’s presentation of wild symbol winning arrangements would be exclusive and hence unique from the presentation of other winning combinations (Office Action, page 3).” Applicants respectfully disagree.

Applicants amended claims 1, 8, 18 and 24 to remove the phrase “uniquely visually differentiating” and replace it with “*distinguishably display(ing)*.” Support for this amendment can be found in paragraphs [0054] through [0061] and Fig. 3 of the published application. No new matter has been introduced. Although the above phrase is not explicitly recited in the specification of the instant US application, it is *inherently* present, i.e., these words concisely describe the subject matter in the specification and Fig. 3. Applicant respectfully submits the following grounds for supporting the inherency.

First, although the Office Action of March 30, 2011 states that the specification “does not exclude the presentation of other wins from being similarly presented (page 3),” it actually does *distinguishably demonstrate* wins with a wild symbol from other wins. As noted at step S5 in Fig. 3, when the reels stop spinning, an evaluation is performed to see if there is a normal game win, or a win based on multiple combinations involving a *shared* wild symbol (paragraph [0053] of the

published application). In other words, the evaluation module of the instant application determines whether the reels result in a *normal game win* or *one containing a wild symbol*. If the multiple win combinations contain a wild symbol, for example, the symbols involved in the wins are “distinguishably displayed” by animation features (S6). Fig. 5 shows an example of animation which vibrates the win arrangements. Also, the shape, the pattern and/or the color of the symbols in the multiple winning combinations may be changed so that the player can easily recognize the wins with a wild symbol ([0055]). Further, the gaming machine of the instant application may also display an audio output. For example, when the multiple win combinations contain a wild symbol, the display may depict a voice shouting “wild” from a hole. This may be supplemented by a voice shouting “wild” through a speaker ([0054], claims 30-33).

However, none of the above features are displayed if a normal win occurs, i.e., there is no wild symbol in the win. In this case, the program goes from evaluation step S5 directly to step S10 which displays the game results. [0061], [0062] This flowchart, as well as the description of the specification, explicitly provides sufficient support for visual (or verbal) differentiation of the wins containing a wild symbol from normal wins. Thus, the specification does exclude the presentation of other wins from being similarly presented.

Second, the inherent presence of the phrase “distinguishably display” is also supported by the priority document JP 2002-343921, filed November 27, 2002, for which Applicants claimed priority at the time of application. During the telephone interview of July 25, 2011, the Examiner kindly informed the Applicant of the rule for incorporation by reference under 37 CFR 1.57(a) (MPEP 201.17). Applicant appreciates the Examiner’s notification. However, it is respectfully noted that Applicant is not attempting to submit something that is *inadvertently omitted* from an application as described in the rule. Rather, Applicant is trying to show support for the phrase “distinguishably display” that has been mistranslated, but is inherently present in the instant US application. By thoroughly reviewing the priority document that was filed in Japanese, Applicant discovered that the above phrase was mistakenly translated in the US application. The priority document clearly describes that a regular game symbol is “displayed (表示),” while the multiple

wins with a wild symbol are “distinguishably displayed (明示).” Note that a different Japanese character is used for each. In the US application, however, both terms were translated as “display” making no distinction between the terms. In addition, Applicant also noticed that the phrase “visually *indicating*” that appears in the paragraph [0073] of the published application should have been translated as “visually *distinguishably displaying*.”

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 112, first paragraph be withdrawn.

Objection to Drawings

The drawings were objected to under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention. In particular, the Examiner states that the “uniquely” identifying wins must be shown. As noted above, claims that contained the word “uniquely” have been amended to eliminate the term. Further, Fig. 3 shows that the display module distinguishably displays multiple wins that include a wild symbol from other wins. Accordingly, Applicants respectfully request that the objection to the drawings under 37 C.F.R. § 1.83(a) be withdrawn.

Rejections Under 35 U.S.C. §103

Claims 1-4, 6, 8-11, 18-20, 22 and 24-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,419,579 of Bennett, in view of U.S. Patent No. 5,766,074 of Cannon et al., in further view of U.S. Patent No. 6,942,572 of Inoue, in yet further view of U.S. Patent No. 6,311,976 of Yoseloff and in still further view of U.S. Patent No. 6,837,790 of Kaminkow. Applicants respectfully traverse these rejections of the claims and request reconsideration.

As can be seen from below table that lists all of prior art references, none of them describe (a) distinguishably displaying multiple wins with a wild symbol, or (b) multiple wins with a shared wild symbol.

Features	Prior Art					
	Bennett	Cannon	Inoue	Yoseloff	Kaminkow	Hamano
Multiple wins	-	-	Yes	Yes	-	-
Wild Symbol	Yes	-	-	Yes	-	-
Symbol in a static array	Implicit	Yes	-	-	-	-
Multiplication factor	Yes	-	-	-	-	Yes
Time interval	-	-	-	Yes	-	-
Vibration	-	-	-	-	Yes	-
Wild symbol that is shared	-	-	-	-	-	-
Win with wild symbol displayed differently	-	-	-	-	-	-

Distinguishably Displaying Multiple Wins with a Shared Wild Symbol

First, Applicant respectfully submits that no prior art reference teaches or suggests displaying multiple winning combinations that include a *common* wild symbol *differently from* other “normal” winning combinations. As will be shown below, for this reason alone, all of the claims are patentable.

In addition to the amendment discussed above, claims 1, 8, 18 and 24 have been also amended to further define the invention by reciting that the distinguishably displaying is “...such that one can easily recognize multiple wins that include at least one wild symbol.” Support for this amendment can be found in paragraph [0017] of the published application. No new matter has been introduced.

The present invention discloses a gaming machine comprising a display module and an evaluation module that can recognize multiple winning arrangements of symbols including at least

one wild symbol that is *shared* by the multiple wins. Such winning arrangements are displayed differently from normal wins that do not have a common wild symbol.

Bennett discloses a game machine with a “Die Walker” multiplier feature. When a special feature is triggered, a die appears and starts moving along a path to the positions of the symbols displayed in the machine, until it is stopped by the player or by timing out. The die functions as a wild card symbol. When the die moves to a position in which a winning combination is formed with the other symbols in the window, the win meter increments and the player is paid a prize (*Bennett*, col. 3, line 36 – col. 4, line 29). However, Bennett fails to explicitly disclose displaying game symbols in a *static array* both prior to the start of a game and after the conclusion of a game as recited in claims 1 and 8. As for claims 18 and 24, although the phrase “in a static display” is not explicitly recited in these independent claims, this limitation is inherently present since both claims describe the feature of displaying initial imagery at the start of a game and final imagery at the end of the game comprising a final combination of symbols.

The Examiner cited Cannon to compensate for the missing static array feature. Cannon discloses a device and method for displaying a winning combination by either *not* displaying non-winning results, or by displaying non-winning results in a *faded* manner, in order to avoid confusion. However, if the die is considered a wild symbol, it does not exist in a *static display* at the start of a game as required by claim 1. Thus, the combination of Bennett and Cannon does not disclose the claimed invention in terms of the static display.

The Examiner conceded that the combination of Bennett and Cannon is silent regarding visually differentiating the winning combinations, but cited Inoue to introduce “the unique visual differentiation of winning combinations (Office Action, page 6).” However, Applicant respectfully submits that this combination still fails to disclose the features claimed in the present invention. For example, in Bennett, the winning combinations having a wild symbol are *shown one at a time* as the die moves along. In other words, only a single winning combination is displayed at any given time. If Bennett is combined with Inoue, which discloses a device that can differentiate a

win from another win by displaying different color illumination, the die (wild symbol) would keep moving until it is stopped. During its move, the die may be placed in a spot that is shared by two or more win combinations. However, neither Bennett nor Inoue teaches that those multiple wins with a shared dice are *illuminated differently* from other multiple wins. As a result, one skilled in the art would not be able to distinguishably recognize those wins with a shared dice (wild symbol) from other multiple wins. Let alone *easily* recognize the multiple wins with a wild symbol. Thus, there are no multiple wins that share a wild symbol. Also, such multiple wins with a wild symbol cannot be distinguishably displayed. Accordingly, one of the most essential features of the present invention cannot be realized by the combination of Bennett, Cannon and Inoue.

In addition, one skilled in the art would not combine Cannon and Inoue. Cannon is essentially designed to display only a single winning combination. Cannon expressly states;

[T]he invention reduces the potential of player confusion and frustration resulting from prior art techniques of adding graphics to the display to indicate a winning combination, especially where *numerous winning combinations are simultaneously presented* on the display screen. (Cannon, col. 9, lines 24-28)

Inoue, on the other hand, discloses a gaming device that displays multiple wins. When one of the *plural different wins* occurs, the symbol constituting its win is displayed with the corresponding color, and as a result, the winning condition can be clearly recognized by the game player at a glance. Inoue expressly states that “*upon two winning symbol combinations being illuminated, a first winning symbol combination is illuminated with a first color* (claim 1).” That is, like the present invention, the display device of Inoue is required to present *multiple* winning combinations as a *result display*. However, as noted above, Cannon discloses a method for displaying a *single* winning pattern and explicitly *teaches away* from a video game displaying multiple winning combinations. Accordingly, one of ordinary skill in the art would not be motivated or suggested to combine Cannon with Inoue to obtain the same feature as claimed by the present invention. According to MPEP 2143.01,

The *mere fact* that references can be combined or modified does *not* render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.

In the Office Action, the Examiner noted the claim limitation to “the utilization of a *time interval* to change a wild symbol present in a winning combination” is missing in the combination of Bennett, Cannon and Inoue (Office Action, page 7) and cited Yoseloff to introduce the limitation. In this response, however, this limitation has been removed from claims 1, 8, 18, and 24, and been added to new claims 34-37.

Applicant discusses the combination of Yoseloff with Bennett, Cannon and Inoue, because it is the only other reference cited by the Examiner that teaches a wild symbol. Yoseloff discloses video gaming systems where payouts are awarded for the appearance of symbols. The gaming system of Yoseloff contains wild symbols that morph or change into symbols designating an award of a non-monetary credit (Yoseloff, col. 8, lines 44 – 46). Yoseloff also may present a plurality of winning combinations. However, as a wild symbol morphs into another symbol, the combination also changes (e.g., “a series of cats” as a winning combination changes to “a series of bears”). Thus, Yoseloff has no wild symbol that is shared by multiple wins as required by claim 1.

Further, a rationale similar to that used against the combination of Bennett and Inoue applies to the combination of Yoseloff and Inoue. In particular, Yoseloff does not teach or suggest multiple winning combinations that include a common wild symbol differently from other “normal” winning combinations.

Accordingly, the feature of “distinguishably displaying multiple wins with a shared wild symbol” recited in independent claims 1, 8, 18 and 24 is not disclosed by Bennett, Cannon, Inoue, Yoseloff, or any combinations thereof. Thus, these claims are not obvious in view of the prior art described above.

In the Office Action, the Examiner further cited Kaminkow to introduce a vibration feature and Hamano to introduce a multiplication factor feature. In particular, claims 2, 6, and 22 were

rejected by the combination of Bennett, Cannon, Inoue, Yoseloff and Kaminkow, while claims 7, 14-16, and 23 were rejected by the combination of Bennett, Cannon, Inoue, Yoseloff, Kaminkow and Hamano. These claims directly or indirectly depend on either claim 1 or claim 8 and thus are patentable for the same reason because both Kaminkow and Hamano do not describe the feature of distinguishably displaying multiple wins with a shared wild symbol. Thus, the above claims are not obvious over Bennett in view of Cannon, Inoue, Yoseloff, Kaminkow and Hamano.

New Claims

New claims 30-33 have been added to further define the invention. Support can be found in paragraphs [0054] of the published application. New claims 34 – 37 have been added to incorporate the limitation to a time interval for alternately changing the wild symbol that has been removed from claim 1. No new matter has been introduced.

Conclusion

In light of discussion, claims 1, 8, 18 and 24 are not obvious in view of the prior art. Claims 2-4, 6, 9-11, 19-20, 22 and 25-37 directly or indirectly depend from either claim 1, 8, 18 or 24, and thus, these claims are not obvious either. Accordingly, Applicants respectfully request that all of the rejections under 35 U.S.C. § 103(a) be withdrawn.

FINAL CONCLUSION

In view of the foregoing, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

The Examiner is respectfully requested to contact the undersigned at the telephone number indicated below if the Examiner believes any issue can be resolved through either a Supplemental Response or an Examiner's Amendment.

It is believed that no fee is required for these submissions. Should the U.S. Patent and Trademark Office determine that additional fees are owed or that any refund is owed for this application, the Commissioner is hereby authorized and requested to charge the required fee(s) and/or credit the refund(s) owed to our Deposit Account No. 50-4570.

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Respectfully submitted,

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